

ESTTA Tracking number: **ESTTA471602**

Filing date: **05/09/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Productos Lacteos Tocumbo, S.A. DE C.V.
Granted to Date of previous extension	05/09/2012
Address	2nd SECCIÃ#N AMPLIACIÃ#N DELEG. TLALPAN BENITO JUAREZ No. 37 Mexico City, 14250 MEXICO
Attorney information	STEPHEN L ANDERSON ANDERSON & ASSOCIATES 27247 MADISON AVENUE, SUITE 121 TEMECULA, CA 92590 UNITED STATES attorneys@brandxperts.com, jleon@clattorneys.com Phone:951-296-1700

Applicant Information

Application No	85378387	Publication date	01/10/2012
Opposition Filing Date	05/09/2012	Opposition Period Ends	05/09/2012
Applicant	Paleteria La Michoacana, LLC 2068 Lapham Drive Modesto, CA 95354 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. All goods and services in the class are opposed, namely: Frozen confections, ice cream, ice cream bars, ice cream sandwiches, fruit ices, freezer pops, fruit ice bars
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2830401	Application Date	04/18/2001
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Registration Date	04/06/2004	Foreign Priority Date	NONE
Word Mark	LA FLOR DE MICHOACAN		
Design Mark	<p style="text-align: center;">LA FLOR DE MICHOACAN</p>		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 ICE CREAM		


U.S. Registration No.	3249113	Application Date	12/08/2005
Registration Date	06/05/2007	Foreign Priority Date	NONE
Word Mark	LA FLOR DE MICHOACAN		
Design Mark			
Description of Mark	The mark consists of A GREEN SPIRAL WITH A YELLOW BUTTERFLY ON THE RIGHT SIDE OF THE SPIRAL, A RED AND YELLOW ICE-CREAM POP-STICK IN THE MIDDLE OF THE SPIRAL, AND THE WORDS LA FLOR DE MICHOACAN IN YELLOW IN THE MIDDLE OF THE SPIRAL.		
Goods/Services	<p>Class 016. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Containers for ice made of paper or cardboard</p> <p>Class 021. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Drinking glasses</p> <p>Class 025. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Blouses; Camp shirts; Cap visors; Dress shirts; Hats; Headgear, namely, HATS, CAPS; Jackets; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Shorts; Sport coats; Sport shirts; Suit coats; Sweat pants; Sweat shirts; Sweaters; T-shirts; Tank tops; Tops; Windshirts</p> <p>Class 029. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Frozen fruits; Fruit pulps; Milk; Milk based beverages containing fruit juice; Milk beverages containing fruits; Milk beverages with high milk content; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt</p> <p>Class 032. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Drinking water; Flavored waters; Flavoured waters; Frozen fruit beverages; Frozen fruit-based beverages; Fruit drinks; Fruit-flavored beverages</p> <p>Class 035. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Retail consignment stores in the field of ICE-CREAM AND FLAVOURED</p>		

	<p>WATERS; Retail shops featuring ICE-CREAM AND FLAVOURED WATERS; Retail store services featuring a wide variety of consumer goods of others; Retail variety stores</p> <p>Class 043. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20</p> <p>Serving food and drinks; Serving of food and drink/beverages</p>
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U.S. Application No.	78954490	Application Date	08/17/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LA MICHOACANA NATURAL		
Design Mark			
Description of Mark	<p>The mark consists of the stylized and shaded words "LA MICHOACANA" superimposed above a fruit ice bar with the stylized word "NATURAL" below. All the words are encircled by a broken oval-shaped ring which features a butterfly in the opening at the upper right corner. Color is not claimed herein.</p>		
Goods/Services	<p>Class 030. First use: First Use: 1995/02/08 First Use In Commerce: 2002/02/10</p> <p>Cones for ice cream; Flavored ices; Frozen yoghurt ; Fruit ice; Fruit ice bar; Fruit ices; Ice; Ice candies; Ice cream; Ice cream drinks; Ice cream mixes; Ice cream powder; Ice cubes; Ice milk bars; Ice-cream cakes</p> <p>Class 035. First use: First Use: 1995/02/08 First Use In Commerce: 2002/02/10</p> <p>Retail shops featuring ice cream, fruit bars, drinks and snacks; Retail stores featuring ice cream, fruit bars, drinks and snacks</p>		

U.S. Application No.	78771243	Application Date	12/12/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	<p>The mark consists of A MEXICAN GIRL HOLDING AN ICE-CREAM CONE IN HER RIGHT HAND (LOGO COLORED PINK, BLACK AND WHITE). The color</p>		


	pink appear in the skirt, the ice-cream and the head reboso. The color white appear in the shirt and the belt. The color black appear in the shoes, hair, ice-cream cone and head reboso.
Goods/Services	<p>Class 016. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Containers for ice made of paper or cardboard</p> <p>Class 021. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Drinking glasses</p> <p>Class 025. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Blouses; Camp shirts; Cap visors; Dress shirts; Hats; Headgear, namely, HATS, CAPS; Jackets; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Shorts; Sport coats; Sport shirts; Suit coats; Sweat pants; Sweat shirts; Sweaters; T-shirts; Tank tops; Tops; Windshirts</p> <p>Class 029. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Frozen fruits; Fruit pulps; Glazed fruits; Milk; Milk based beverages containing fruit juice; Milk beverages containing fruits; Milk beverages with high milk content; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt</p> <p>Class 030. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Cones for ice cream; Flavored ices; Frozen yoghurt; Fruit ice; Fruit ice bar; Fruit ices; Ice; Ice candies; Ice cream; Ice cream drinks; Ice cream mixes; Ice cream powder; Ice cubes; Ice milk bars; Ice-cream cakes</p> <p>Class 032. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Drinking water; Flavored waters; Flavoured waters; Frozen fruit beverages; Frozen fruit-based beverages; Fruit beverages; Fruit drinks; Fruit juice bases; Fruit juices; Fruit-flavored beverages; Fruit-flavored drinks; Fruit-flavoured beverages; Iced fruit beverages</p> <p>Class 035. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Retail consignment stores featuring ICE-CREAM AND FLAVOURED WATERS; Retail consignment stores in the field of ICE-CREAM AND FLAVOURED WATERS; Retail store services featuring a wide variety of consumer goods of others; Retail variety stores</p> <p>Class 043. First use: First Use: 2001/04/20 First Use In Commerce: 2001/04/20 Serving food and drinks; Serving of food and drink/beverages</p>

U.S. Application No.	85405347	Application Date	08/23/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LA MICHOACANA		
Design Mark			
Description of Mark	NONE		

Goods/Services	<p>Class 016. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Blank or partially printed paper labels; Bottle wrappers of cardboard or paper; Boxes of cardboard or paper; Boxes, cartons, storage containers, and packaging containers made of paper or cardboard; Cardboard cartons; Containers for ice made of paper or cardboard; Packaging containers of paper; Paper cartons for delivering goods; Paper take-out cartons for food; Storage containers made of paper</p> <p>Class 021. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Beverage glassware; Cups; Ice cream scoops; Paper and plastic cups</p> <p>Class 025. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Baseball caps and hats; Cap visors; Caps; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Sport shirts; T-shirts; Visors</p> <p>Class 029. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Beverages having a milk base; Dairy products excluding ice cream, ice milk and frozen yogurt; Dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt</p> <p>Class 030. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Coffee based beverages; Cones for ice cream; Edible fruit ices; Flavorings for beverages; Frozen yoghurt; Fruit ice; Fruit ice bar; Ice candies; Ice cream; Ice cream desserts; Ice cream drinks; Ice-cream cakes</p> <p>Class 032. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Bottled drinking water; Flavored waters; Frozen fruit beverages; Fruit beverages; Fruit juices and fruit drinks; Fruit-based beverages; Ice cream soda; Smoothies; Sorbets in the form of beverages</p> <p>Class 035. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Retail ice cream store services</p> <p>Class 039. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Distribution services, namely, delivery of dairy products, ice-cream, flavored waters and bottled drinking waters</p> <p>Class 043. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Ice cream parlors; Ice cream shop services in the nature of a restaurant</p>
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U.S. Application No.	85408561	Application Date	08/26/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LA MICHOCACANA NATURAL		
Design Mark			
Description of Mark	The mark consists of the words "LA MICHOCACANA" in stylized letters, above the word "NATURAL". At the center of the mark, there is an ice cream bar on a stick. All the words are encircled by a broken oval-shaped ring, which features a		

	butterfly in the opening at the upper right corner.
Goods/Services	<p>Class 016. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Blank or partially printed paper labels; Bottle wrappers of cardboard or paper; Boxes of cardboard or paper; Boxes, cartons, storage containers, and packaging containers made of paper or cardboard; Cardboard cartons; Containers for ice made of paper or cardboard; Packaging containers of paper; Paper cartons for delivering goods; Paper take-out cartons for food; Storage containers made of paper</p> <p>Class 021. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Beverage glassware; Cups; Ice cream scoops; Paper and plastic cups</p> <p>Class 025. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Baseball caps and hats; Cap visors; Caps; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Sport shirts; T-shirts; Visors</p> <p>Class 029. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Beverages having a milk base; Dairy products excluding ice cream, ice milk and frozen yogurt; Dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt</p> <p>Class 032. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Bottled drinking water; Flavored waters; Frozen fruit beverages; Fruit beverages; Fruit juices and fruit drinks; Fruit-based beverages; Ice cream soda; Smoothies; Sorbets in the form of beverages</p> <p>Class 039. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Distribution services, namely, delivery of dairy products, ice-cream, flavored waters and bottled drinking waters</p> <p>Class 043. First use: First Use: 1995/02/08 First Use In Commerce: 2001/03/30 Ice cream parlors; Ice cream shop services in the nature of a restaurant</p>

U.S. Application No.	76244918	Application Date	04/18/2001
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LA MICHOACANA NATURAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: ICE CREAM		

Related Proceedings	92047438 91205049
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Attachments	76244917#TMSN.gif (1 page)(bytes) 78769546#TMSN.jpeg (1 page)(bytes) 78954490#TMSN.jpeg (1 page)(bytes) 78771243#TMSN.jpeg (1 page)(bytes) 85405347#TMSN.jpeg (1 page)(bytes) 85408561#TMSN.jpeg (1 page)(bytes) 76244918#TMSN.gif (1 page)(bytes) 85378387- NOTICE OF OPPOSITION.pdf (15 pages)(157959 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/StephenLAnderson/
Name	STEPHEN L ANDERSON
Date	05/09/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application No. 85378387

Mark: LA INDITA

Published: January 10, 2012

PRODUCTOS LACTEOS TOCUMBO
S.A. DE C.V.,

Petitioner,

vs.

PALETERIA LA MICHOACANA, LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Mark: LA INDITA

Petitioner, Productos Lacteos Tocumbo S.A. de C.V., a corporation organized and existing under the laws of Mexico, located and doing business at Benito Juarez No. 37 2nd Sección Ampliación Delegación Tl Alpa, Mexico City, Mexico (“Opposer”) believes that it will be damaged by registration of the mark LA INDITA as shown in the above-identified application filed on July 22, 2011 (“the subject application”) by Applicant, Paleteria La Michoacana LLC, (“Applicant”), for “[f]rozen confections, ice cream, ice cream bars, ice cream sandwiches, fruit ices, freezer pops, fruit ice bars,” in International Class 030 and hereby opposes the registration of such mark.

The grounds for opposition are as follows:

1. Opposer is a leading retailer/dealer/distributor of cones for ice cream, ice cream cakes, flavored ices, frozen yogurts, fruit ices, fruit ice bars, ice, ice candies, ice cream, ice cream drinks, ice cream mixes, ice cream powder, ice cubes, ice milk bars and retail shops and/or stores featuring same. Opposer and its authorized licensees own and operate retail stores and distributorships in the United States and Mexico featuring such dairy products, edible ices, ice cream, fruit bars, drinks and snacks.

2. Since at least as early as February 1985, Opposer has also maintained an ice

cream manufacturing and distribution center in the State of Michoacán in Mexico.

3. Since at least as early as February 8, 1995, Opposer and its related company or licensee(s) has/have adopted and continuously used the marks LA MICHOACANA, LA



MICHOACANA NATURAL, (and design)

(hereinafter “LA

MICHOACANA NATURAL (and design)”) LA MICHOACANA and ice cream design



and the design of an Indian girl (commonly known as “LA



INDITA” and also known as “DISEÑO INDITA”) shown here:

in Mexico,

and elsewhere, in connection with the sale and distribution of various goods and services, particularly including those within International Classes 29, 30, 32, 35 and 39, namely including, inter alia: eggs, milk and dairy products; cones for ice cream, ice cream cakes, flavored ices, frozen yogurts, fruit ices, fruit ice bars, ice, ice candies, ice cream, ice cream drinks, ice cream mixes, ice cream powder, ice cubes, ice milk bars; mineral waters, sodas, purified waters and other non-alcoholic beverages; beverages and fruit juices; syrup and other preparations to make beverages; retail stores and shops featuring ice cream, fruit bars, drinks and snacks; distribution,

transport, packaging and storage services of goods, in particular dairy products, milk, edible ices, and lollipop sticks for edible ices.

4. Opposer and its related company, is the beneficial owner or licensee of the following valid and subsisting trademark registrations, inter alia, as were issued by the Mexican Institute of Intellectual Property:

- (a) Registration No. 500870 for the trademark LA MICHOACANA NATURAL (and design) in connection with “edible ice-creams” in International Class 30 (filed February 8, 1995, registered August 11, 1995, renewed May 27, 2005);
- (b) Registration No. 852057 for the trademark LA MICHOACANA NATURAL (and design) as used since February 8, 1995, in connection with “meat, fish, poultry and hunt; meat extracts; preserved fruits and vegetables, dried or cooked; jellies, jams compotes; eggs, milk and dairy products; oils and fats” in International Class 29 (filed November 4, 2002, registered September 22, 2004);
- (c) Registration No. 781733 for the trademark LA MICHOACANA NATURAL in connection with “beers; mineral waters and sodas and other non-alcoholic beverages; beverages and fruit juices; syrup and other preparations to make beverages; especially purified water” in Class 32 (filed September 4, 2002, registered February 28, 2003); and
- (d) Registration No. 845194 for the trademark LA MICHOACANA NATURAL (and design) as used since February 8, 1995, in connection with “distribution services of dairy products in general” in International Class 39. (filed May 26, 2004, registered August 3, 2004).

5. Opposer is also the owner of Community Trade Mark Certificate of Registration No. 003095403 for the mark LA MICHOACANA NATURAL (and design) registered by the World Intellectual Property Organization on June 14, 2004 in connection with: “Meat, fish, poultry and game; meat extracts; preserved fruits and vegetables, dried or cooked; jellies, jams, fruit sauces, eggs milk and milk products, edible oils and fats;” “Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, edible ices, lollipop sticks for edible ices, thickeners and powders for edible ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices ice;” and “Distribution, transport, packaging and storage of goods, in particular dairy products,

milk, edible ices, lollipop sticks for edible ices.”

6. Since at least as early as April 20, 2001, Opposer and its related company or licensee(s) has/have adopted and continuously used the marks LA FLOR DE MICHOACAN in United States commerce in connection with “ice cream” in International Class 030.

7. Opposer is the owner of the incontestable United States Trademark Certificate of Registration No. 2,830,401 for the mark LA FLOR DE MICHOACAN, (words only) registered on April 06, 2004, which remains valid and subsisting on the Principal Register. Opposer is also the owner of the mark LA FLOR DE MICHAOCAN (and design) shown here:



which it and its licensees have continuously used in United States commerce since at least as early as April 20, 2001. Such mark was registered by the USPTO under Registration No. 3,249,113 on June 05, 2007 in connection with a variety of goods and services, particularly including those within International Classes 16, 21, 25, 29, 32, 35, 39 and 43, including, inter alia: containers for ice made of paper or cardboard, drinking glasses; various items of clothing; frozen fruits, fruit pulps, milk based beverages containing fruit juice, drinking water, flavored waters, frozen fruit-based beverages, fruit drinks, fruit-flavored beverages; retail shops featuring ice-cream and flavoured waters; and serving food and drinks.

8. Opposer has applied for U.S. Registration for its marks, including LA MICHOACANA NATURAL (and design) (Application Serial No. 7895490 filed August 17, 2006) and the design of an Indian girl, (Application Serial No. 78771243 filed December 12,



2005) shown here: . Both such applications have each been suspended pending the formal cancellation of Registration No. 3,210,304 (owned by a related third party) for the mark LA INDITA MICHOACANA and design shown here:



9. Opposer has also applied for U.S. Registration for its marks, including LA MICHOACANA (words only), (Application Serial No. 85405347) and LA MICHOACANA NATURAL (and design), (Application Serial No. 85408561) which applications have respectively been approved for publication by the USPTO.

10. Applicant's application for the proposed mark LA INDITA as was filed under application Serial No. 85393112 was filed on the basis of the Applicant's Intent-To-Use such mark and therefore claims no date of first use.

11. Opposer's family of marks which specifically include the marks: LA MICHOACANA, LA MICHOACANA NATURAL,



and



, LA FLOR DE



MICHOACAN,

and its Indian Girl design known as LA INDITA:



have each been continuously used by Opposer to designate its own goods and services as related to the manufacture, distribution and sale of ice cream, fruit ice bars and related dairy products and services became famous in such connection long prior to the filing of the opposed application and prior to any use of the subject mark LA INDITA MICHOACANA (and design). Registration of the subject mark by the Applicant in connection with “[f]rozen confections, ice cream, ice cream bars, ice cream sandwiches, fruit ices, freezer pops, fruit ice bars,” in International Class 030 is likely to cause injury to Opposer and Opposer’s rights in its respective marks identified herein. Further, Registration and use of the subject mark by the Applicant would dilute the distinctiveness of Opposer’s marks, namely including: LA MICHOACANA, LA MICHOACANA NATURAL, (and design)



LA MICHOACANA (and ice cream design)



LA FLOR DE MICHOACAN, LA FLOR DE MICHOACAN (and



design)

and the design of an Indian girl (commonly known as “LA



INDITA”) shown here:

12. Indeed, for more than eleven (11) years, since at least as early as April 2001, and well prior to the filing of the subject trademark application (Serial No. 85378387), (and well prior to the alleged adoption of the confusingly similar mark shown in Registration No. 3,210,304, which was ordered to be cancelled by the Board), Opposer had adopted and has continually used each of its aforementioned marks, its family of related trademarks, and service marks including: LA MICHOACANA, LA MICHOACANA NATURAL, LA MICHOACANA NATURAL (and design), LA MICHOACANA NATURAL (and ice cream design), LA FLOR DE MICHOACAN, LA FLOR DE MICHOACAN (and design) and its Indian girl design known

as “LA INDITA” in United States commerce. Opposer and its authorized licensees have extensively used each such mark, including: LA MICHOACANA, LA MICHOACANA



NATURAL,



and



LA FLOR DE MICHOACAN,

and its own Indian Girl design mark



(commonly known as LA INDITA:

continuously used by Opposer and its

authorized licensees in United States commerce since at least as early as April 20, 2001 in connection with ice cream and related products and services and have invested substantial time, money and effort in advertising such marks. Opposer has licensed, sold and marketed its branded and authorized goods and services throughout the United States, Mexico and beyond, by various trade channels, including for example, through Opposer’s and its licensees’ retail stores, through Opposer’s authorized distributors, and through resellers of Opposer’s products, particularly, ice cream and fruit ice bars commonly known as “paletas.”

13. As the result of Opposer’s continuous and widespread use of Opposer’s marks, and the goods respectively sold under such mark, with the result that the purchasing public has come to know, rely upon, and recognize the products of Opposer by such marks. For at least

eleven years, Opposer and its authorized licensees have used the Opposer's marks, including LA MICHOACANA, LA MICHOACANA NATURAL , LA FLOR DE MICHOACAN and the Indian Girl Design as related brand-source indicators within its promotional materials and on store signage and menus, in connection with a wide variety of Opposer's ice cream goods and related services as are mentioned herein. Opposer has acquired extensive goodwill and considerable fame in connection with such marks, which have further developed a high degree of distinctiveness and recognized as identifying quality goods and services which have their origin with, or have otherwise been authorized by the Opposer.

14. There is no issue as to priority of use. Applicant's filing date of the subject application of August 09, 2011, on the basis of intent-to-use such mark is more than ten years after the Opposer first used its own marks, including LA MICHOACANA, LA MICHOACANA NATURAL , LA FLOR DE MICHOACAN and the Indian Girl Design in United States commerce in connection with ice cream and related goods and services.

15. Upon information and belief, Applicant has made no use of the subject mark LA INDITA as a trademark in the United States.

16. The trademark proposed for registration by the Applicant, namely the words LA INDITA uses the same prefix "LA" as each of the Opposer's marks and in and of itself raises the substantially identical mark and is confusingly similar to the Opposer's Indian Girl design mark known as LA INDITA.

17. Within the subject application for the word mark LA INDITA, the Applicant has claimed ownership of the prior registration No. 3,210,304, which was ordered to be Cancelled by the TTAB on May 20, 2011 on the grounds that Opposer had priority of use of the following trademarks which each gave rise to a likelihood of confusion with the registered LA INDITA MICHOACANA and Indian Girl Design Mark: (1) the terms LA MICHOACANA NATURAL;

(2) the terms LA MICHOACANA NATURAL displayed with a butterfly design; (3) the design



of an Indian Girl in traditional clothing holding an ice cream and the word mark LA MICHOACANA.

18. If the Applicant's LA INDITA mark were applied to ice cream goods similar to those sold by Opposer, the Applicant's mark would be likely to be confused with the Opposer's marks. The Applicant's mark is deceptively similar to Opposer's marks so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing the Applicant's proposed mark.

19. Opposer is further informed and believes that the subject mark was adopted and the subject application was filed by Applicant in bad faith and with the intent to deceive the public regarding the source and origin of the Applicant's intended goods and specifically with the intent to falsely suggest an association with Opposer where none exists. For example, Applicant's President, Ignacio Gutierrez, has testified under oath, that prior to 1986, while he was in Mexico, and "long before he had ever started making any ice cream" that he had observed the term "La Michoacana" used, in Mexico in relation to ice cream, that he had visited "various ice cream shops that had the words "La Michoacana" on the front", and that "[s]ome of them used the Indian girl (design) and some of them use(d) a different, you know, different version of the Indian girl." Similarly, Applicant's Vice-President, Patricia Gutierrez has testified under oath that she had been born in Mexico, where she had lived for 16 years prior to coming to the United States, and that in 1999, that she had seen the term "La Michoacana" used at "[s]everal ice cream parlors throughout different cities in Mexico;" that [s]ome of them would have 'La Michoacana,'

some of them would have ‘La Michoacana es Natural,’ some of them would have a little girl,” which she later clarified to include “the little Indian girl design.”

20. Further, although Ignacio Gutierrez and Patricia Gutierrez and the Applicant itself were each respectively aware, and should have been aware that on May 20, 2011 a United States Trademark Trial & Appeal Board panel had granted Opposer’s Petition For Cancellation of Registration No. 3,210,304 and had cancelled the registration of the highly similar mark LA



INDITA MICHOACANA (and design) shown here: (TTAB Cancellation

No.: 92047438), as had been registered to a third party, namely Paleteria La Michoacana, INC., subsequent to the Board’s decision, Applicant filed the subject application with knowledge that the Board had specifically found that Opposer had priority of use of each of the following trademarks:

- (i) **LA MICHOACANA** (words only);
- (ii) **LA MICHOACANA NATURAL** (words only);
- (iii) **LA MICHOACANA NATURAL** (and design): ;
- (iv) (design of an “Indian girl”):
- (v) **LA FLOR DE MICHOACAN** (words only);
- (vi) **LA FLOR DE MICHOACAN** (and design),”

which each gave rise to a likelihood of confusion with the prior asserted mark **LA INDITA MICHOACANA** (and design).

21. Notwithstanding such knowledge, upon information and belief, Ignacio Gutierrez as “President” of the Applicant in the subject application, namely Paleteria La Michoacana, LLC,

on August 8, 2011 falsely and fraudulently declared with the intent to deceive the public and the United States Patent & Trademark Office, inter alia, that: "...being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief, no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true...."

22. However, the subject mark proposed for registration by the Applicant, namely the words LA INDITA raises a highly similar formative as compared to the Opposer's marks LA MICHOACANA, LA MICHOACANA NATURAL and LA FLOR DE MICHOACAN, and also raises the same common name and graphical image as the Opposer's Indian Girl design (LA



INDITA) so that when Applicant's subject mark is applied to the Applicant's intended goods including ice cream, frozen confections and fruit ice bars, it so nearly resembles the Opposer's marks as to be likely to be confused therewith and mistaken therefor. The Applicant's mark is deceptively similar to Opposer's marks so as to cause confusion and lead to

deception as to the origin of the Applicant's goods bearing the Applicant's proposed subject mark.

LIKELIHOOD OF CONFUSION

23. Applicant's use of the subject mark in association with its intended goods is likely to cause confusion, or to cause mistake, or to deceive, in view of Opposer's long-standing prior use of its arbitrary and distinctive marks and family of marks, including LA MICHOACANA, LA MICHOACANA NATURAL, LA FLOR DE MICHOACAN and its Indian Girl Design.

24. Concurrent use of the mark by the Applicant and the Opposer may likely result in irreparable damage to Opposer's reputation and goodwill, if the goods sold by the Applicant are inferior, since purchasers are likely to attribute the source of the Applicant's goods to the Opposer.

25. Applicant's goods are identical to and/or closely related to the Opposer's ice cream goods and related services sold and provided in connection with each of the Opposer's marks mentioned herein. Applicant's goods branded with the subject mark as used in connection with ice cream and fruit ice products, and fruit bars, would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of purchasers.

26. Applicant's use of the mark LA INDITA in connection with its proposed goods is likely to cause confusion, mistake or deception as to the source and origin of Opposer's goods in that the public, the trade and others are likely to believe that Applicant's goods are (a) the same goods as Opposer's; or (b) provided by, sponsored by, approved by, licensed by affiliated with or in some other way are legitimately connected to Opposer and its goods and services or licensed products. Use of the mark as described under the subject application would cause public confusion, and deception and damage and injury to Opposer.

27. Accordingly, the grant of a registration to Applicant for the mark sought in the subject application should be denied under Section 2(d) of the Trademark Act, particularly in light of Petitioner's prior use of the distinctive marks mentioned above, which each had become long famous before the claim of any rights in the highly similar mark LA INDITA with respect to ice cream and fruit ice products and fruit bars.

LIKELIHOOD OF DILUTION

28. Applicant's use and registration of the subject mark in association with its intended goods is likely to cause dilution of the distinctive quality of the Opposer's famous marks, by tarnishment and blurring, in view of Opposer's long-standing prior use of its arbitrary and distinctive marks and family LA MICHOACANA, LA MICHOACANA NATURAL, LA FLOR DE MICHOACAN and its Indian Girl Design in association with the sale, distribution, and advertising of a wide variety of goods, particularly including ice cream and fruit ice bars and related goods and services as are described above.

29. Applicant's proposed use of such a highly similar mark would further cause dilution to the distinctive quality of Petitioner's famous marks.

30. Opposer will be further damaged by the registration sought by Applicant because such registration would support and assist Applicant in use of its proposed mark and thereby dilute Petitioner's exclusive rights in its distinctive and famous trademarks.

31. By reason of Opposer's use of the marks LA MICHOACANA, LA MICHOACANA NATURAL, LA MICHOACANA (and design) LA FLOR DE MICHOACAN, LA FLOR DE MICHOACAN (and design) and its Indian Girl Design from long prior to the date of Applicant's filing of the subject application to register the nearly identical mark LA INDITA MICHOACANA (and design) for use in association with identical or highly related goods, Opposer has superior rights to any rights of the Applicant.

32. The registration to Applicant of the subject mark will interfere with Opposer's use and enjoyment of its rights in its marks, to Opposer's substantial detriment.

INTENT TO DECEIVE- FRAUD IN THE APPLICATION

33. Upon information and belief, the subject mark was applied for by Applicant with knowledge of the Opposer's prior use and rights in the Opposer's marks and after the Board had determined that the Opposer had prior and superior rights in its marks, including **LA MICHOACANA** (words only); **LA MICHOACANA NATURAL** (words only); **LA MICHOACANA NATURAL** (and design); **Indian Girl Design**; **LA FLOR DE MICHOACAN** (words only); and **LA FLOR DE MICHOACAN** (and design).

34. Notwithstanding the Opposer's rights, upon information and belief, Applicant filed the subject application with the intent to deceive or disparage the Opposer, and with the intent of falsely suggesting an association with the Opposer where none exists.

35. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use the subject mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and Applicant's Application to register the mark LA INDITA MICHOACANA (and design) be denied.

The fee of \$300.00 required by Section 2.6(a)(16) is enclosed herewith.

Respectfully submitted,

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